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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/779,203	02/07/2001	Ronald E. Pehrline	SRIIP028/4431-2	5665
22434	7590	08/13/2002		
BEYER WEAVER & THOMAS LLP P.O. BOX 778 BERKELEY, CA 94704-0778				EXAMINER MEDLEY, PETER M
			ART UNIT 2834	PAPER NUMBER

DATE MAILED: 08/13/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/779,203	PELRINE ET AL. <i>ME</i>	
	<b>Examiner</b>	<b>Art Unit</b>	
	Peter M Medley	2834	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) Responsive to communication(s) filed on 31 May 2002.

2a) This action is **FINAL**.                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) Claim(s) 1-31 and 33-37 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-31 and 33-37 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \*    c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>7,9</u> .	6) <input type="checkbox"/> Other: _____

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-5, 8-22, 27, and 32-37 are rejected under 35 U.S.C. 102(b) as being anticipated by Pelrine et al ("Electrostriction of polymer dielectrics with compliant electrodes as a means of actuation").

With respect to claims 1, 15-22, 27, and 37, the reference discloses in **fig. 6** a transducer with two active areas, left and right electroded areas, and that the actuator is pre-strained. The method is necessitated by the structure.

With respect to claims 2, 3, and 35, the first and second active areas of **fig. 6** are linearly aligned and arranged symmetrically.

With respect to claim 4, the areas in **fig. 6** are diametrically arranged around the output member.

With respect to claim 5, the electrical communication is independent.

With respect to claims 8 and 11, the transducer in **fig. 6** is anisotropically strained.

With respect to claims 9 and 36, the reference discloses an output member to be used as a motor.

With respect to claims 10, 12-14, and 34, the reference discloses a rigid member in between the first and second active regions in **fig. 6**.

With respect to claim 33, the reference discloses a frame in **fig. 6**.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 6, 7, 23-26, and 28-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pelrine et al ("Electrostriction of polymer dielectrics with compliant electrodes as a means of actuation").

With respect to claims 6, 7, 28-29, and 31, the reference discloses in **fig. 6** a transducer with two active areas, left and right electroded areas, and that the actuator is pre-strained.

The reference does not disclose the use of a common electrode.

The Examiner takes Official Notice that the use of a common electrode would have been well known for the purpose of providing a common ground.

It would have been obvious to one ordinary skill in the art to modify Pelrine et al to have a common electrode for the purpose of providing a common ground.

With respect to claims 23-26, the reference does not disclose more active regions.

The Examiner takes Official Notice the it would have been well known to add additional active areas for the purpose of increasing the number degrees of freedom of the output device.

It would have been obvious to one of ordinary skill in the art add active areas to the device of Pehrine et al for the purpose of making a device with more than one degree of freedom.

With respect to claim 30, the reference does not disclose the resistivity of the common electrode.

The Examiner takes Official Notice that one of ordinary skill in the art would have known that the resistivity would affect the response of the device. The court has stated that where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation. *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955). It would have been obvious to one of ordinary skill in the art to use electrodes with the claimed resistivity for the purpose of affecting the response of the device.

#### ***Response to Arguments***

3. Applicant's arguments filed 31 May 2002 have been fully considered but they are not persuasive.

With respect to the IDS, paper #4 filed 8 August 2001, the IDS has been considered in its entirety.

A new grounds of rejection has been given because of the amendments.

***Conclusion***

4. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter M Medley whose telephone number is 703-305-0494. The examiner can normally be reached on Monday-Friday 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nestor Ramirez can be reached on 703-308-1371. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3432 for regular communications and 703-305-3432 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.

PM  
August 12, 2002

  
NESTOR RAMIREZ  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2800